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FROM: Courtney Benjamin
IP Docket Clerk
214.969.1485

DATE: August 30, 2005

SUBJECT: Office Action for Application 09/730,219

Enclosed please find the above mentioned office action, sent to Thompson & Knight LLP in error. Per the examiner's request, I am sending this document back for rerouting to the correct person(s).



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,219	12/05/2000	Ghassan Chidiac	YOR920000746US1	9167

27644 7590 08/24/2005

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PATENT PROSECUTION DEPARTMENT
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EXAMINER

ALAM, SHAHID AL

ART UNIT	PAPER NUMBER
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DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



NEW CENTRAL FAX NUMBER

Effective July 15, 2005

On July 15, 2005, the Central FAX Number will change to **571-273-8300**. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number. To give customers time to adjust to the new Central FAX Number, faxes sent to the old number (703-872-9306) will be routed to the new number until September 15, 2005.

After September 15, 2005, the old number will no longer be in service and **571-273-8300** will be the only facsimile number recognized for "centralized delivery".

CENTRALIZED DELIVERY POLICY: For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the Central FAX number, unless an exception applies. For example, if the examiner has rejected claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number.



Office Action Summary

Application No.

09/730,219

Applicant(s)

CHIDIAC ET AL.

Examiner

Shahid Al Alam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Appeal Brief on May 16, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of the Appeal Brief filed on 16 May 2005, PROSECUTION IS HEREBY REOPENED. The rejection set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

After an Appeal Conference on August 3, 2005, Conferees decided to withdraw the Finality of the last Office action and therefore, the finality of that action is withdrawn.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 – 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 1, the phrase "A method" renders the claim indefinite because it is unclear whether this method is a manual method or a computer implemented method.

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Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 – 11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

MPEP 2106 IV.B.2.(b) A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.

MPEP 2106.II.A A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See In re Warmerdam, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

Claim 1 in view of the above cited MPEP sections, are not statutory because they merely recite a number of computing steps without producing any tangible result and/or being limited to a practical application within the technological arts. **The use of a computer has not been indicated.**

This claim does not indicate use of hardware on which the software runs to perform the steps recited in the body of the claim. Software or program can be stored on a medium and/or executed by a computer. In other words the software must be computer-readable. **The use of a computer is not evident in the claim.** MPEP 2106.IV.B.1(a) refers to "computer-readable" medium with computer program encoded on it."

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 5,608,874 issued to Stuart Ogawa et al. ("Ogawa") and in view of Applicants' Admitted Prior Art ("APA").

With respect to claim 1, Ogawa teaches a method for selecting a file format from a plurality of stored file formats for use in performing a translation from said selected file format to a requested file format (see Abstract), the method comprising the steps of:

receiving a request for a data file in a requested format (column 34, lines 17 – 19);

determining a file format from a plurality of stored files for use in performing said translation to said requested file format (column 2, lines 30 – 36 and lines 54 – 61); and

translating the file format of said data file determined in said determining step to the requested file format (column 2, lines 54 – 61 and column 34, lines 60 – 64).

Ogawa does not explicitly teach an optimal file format from a plurality of stored file formats as claimed.

APA discloses claimed optimal file format from a plurality of file format. APA discloses a requested data file exists within an enterprise in many different formats

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other than the requested format, . . . for selecting the optimal version of a requested data file from which to perform the translation (see APA, 2nd Paragraph of page 3).

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine APA with Ogawa to automatically understand what specific format translations are needed for a specific data recipient, then to be able to automatically carry out such a translation regardless of what format the data was originally in. It would be desirable for a system to operate with minimal user interaction, making it faster, cheaper, and more reliable than manual or semiautomatic performance of such tasks (column 2, lines 30 – 43; Ogawa).

As to claims 2 and 3, Ogawa teaches all of the limitation as claimed except Ogawa does not explicitly teach minimizing data loss and minimizing file size as claimed.

APA teaches claimed minimization and optimization by selecting the optimal version of a requested data file from which to perform the translation (see APA, 2nd Paragraph of page 3).

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine APA with Ogawa to automatically understand what specific format translations are needed for a specific data recipient, then to be able to automatically carry out such a translation regardless of what format the data was originally in. It would be desirable for a system to operate with minimal user interaction, making it faster, cheaper, and more reliable than manual or semiautomatic performance of such tasks (column 2, lines 30 – 43; Ogawa).

As to claim 4, determining step is based upon the requested file format and available stored file formats (column 34, lines 17 – 50).

As to claim 5, wherein said determining step further includes the step of consulting an optimized list of file formats from which to perform said translation of said stored data file to the requested file format (Ogawa: column 16, lines 18 – 23; Note that the “Subscriber Translation Information” of Ogawa reads on an optimized list of file formats).

As to claim 6, said list is indexed by said requested file format (column 34, lines 50 – 64).

As to claim 7, said optimized list is consulted if the data file is stored in a plurality of formats (Ogawa: column 16, lines 18 – 23; Note that the “Subscriber Translation Information” of Ogawa reads on an optimized list of file formats and see also APA, 2nd Paragraph of page 3).

As to claim 8, said consulting step further includes selecting one of said optimized list from a plurality of said optimized lists (Ogawa: column 16, lines 18 – 23; Note that the “Subscriber Translation Information” of Ogawa reads on an optimized list of file formats and see also APA, 2nd Paragraph of page 3).

As to claim 9, ordering of said optimized lists is based on criterion regarding the translation to be performed on the stored data file (column 2, line 59 – column 3, line 4).

As to claim 10, said criterion is defined by a received request for said data file (column 2, line 59 – column 3, line 4).

As to claim 11, accessing a portion of said optimized list ordered based upon the requested file format; determining whether one or more of said listed file formats exists as one of said stored file formats; and selecting from said optimized list the optimal file format that is determined to exist as a stored file format (a requested data file exists within an enterprise in many different formats other than the requested format, . . . for selecting the optimal version of a requested data file from which to perform the translation (see APA, 2nd Paragraph of page 3 and also Ogawa: column 16, lines 18 – 23; Note that the “Subscriber Translation Information” of Ogawa reads on an optimized list of file formats).

The subject matter of claims 12 – 23 are rejected in the analysis above in claims 1 – 11 and these claims are rejected on that basis.


Contact Information

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid Al Alam whose telephone number is (571) 272-4030. The examiner can normally be reached on Monday-Thursday 8:00 A.M.- 4:00 P.M..


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Shahid Al Alam
Primary Examiner
Art Unit 2162

19 August 2005

Supervisory

CHARLES RONES
PRIMARY EXAMINER